proper and no longer applies. Applicant again requests that the examiner withdraw the restriction requirement or invites the examiner to explain how the reasoning set forth in the action of March 9, 2006 applies to the claims in their current form. Further, claim 31 includes features similar to those listed in claim 11, how can claim 31 be examinable and not claim 11?

Claims 1, 2, 4, 9-10, 13-16, 18-20, 24-30, and 32-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kodweiss et al. (US 6830024). Claim 1 recites that the first and second shells are each single-piece shells with the resonator being integrally and completely formed as part of the first and second single-piece shells. Kodweiss does not disclose this feature.

The examiner argues that it would have been obvious to modify Kodweiss to use two single piece shells in lieu of one single piece shell 22 and another shell made from two pieces 20, 30 as it has been held that forming on one piece an article which has formerly been formed in two pieces an put together involves only routine skill in the art. Applicant respectfully asserts that there is no motivation or suggestion to modify Kodweiss in the manner proposed by the examiner.

Kodweiss discloses a first shell 20, a second shell 22, and a cover 30 that is used to form part of the resonator. Thus, Kodweiss discloses that three separate pieces are required to form the resonator. Further, based on the teachings of Kodweiss, the cover 30 cannot be formed as part of the shell 20. Kodweiss discloses a two piece shell configuration with top shell 20 and bottom shell 22 defining a resonance space 24. The intake air flows through the resonance space 24 and into the cylinder heads. In the top shell 20, an outer wall section 28 is required, which includes openings 26 that are part of a reflection chamber 29 that is coupled to the resonance space 24 to provide a resonator. The wall section 28 is closed off toward the outside by a cover 30. The reflection chamber 29 is linked to the resonance space by way of the openings 26 to help reduce noise. See col. 2, lines 34-54.

As set forth at MPEP 2143, to establish a prima facie case of obviousness there must be some suggestion or motivation to modify the reference, there must be a reasonable expectation of success, and the reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must

both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully asserts that there is no motivation or suggestion to modify Kodweiss in the manner proposed by the examiner.

The proposed modification cannot render the prior art unsatisfactory for its intended purpose (see MPEP 2143.01 (V)) and cannot change the principle of operation of a reference (see MPEP 2143.01 (VI)). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 7233 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The object of Kodweiss was to provide an improved suction system for an engine with a resonator that muffles noise without impairing suction airflow. Kodweiss stated that this objective was achieved by a suction system in which openings required to form the resonator chamber are provided in a wall section, and are closed off by a cover that seals off the openings toward the outside. "As a result, the flow-optimized interior structure of the suction system remains unchanged, and the inflow behavior of the taken-in combustion air is not affected." Col. 1, lines 45-49.

The examiner argues that it would be obvious to modify Kodweiss to form components 20, 30 as one piece because forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. It is clear that forming elements 20, 30 as a single piece would not involve simply routine skill in the art. Kodweiss specifically teaches forming holes in a portion of an outer wall of element 20 which is then subsequently closed off by a cover 30. To modify the shell 20 and cover 30 of Kodweiss would clearly render Kodweiss unsatisfactory for its intended purposes, especially as the entire invention of Kodweiss is directed to forming openings in the outer wall of shell which are closed off by a separate cover. Further, it simply would not be possible from manufacturing standpoint to form the components together in one piece in the manner suggested by the examiner.

Thus, claim 1 is allowable over Kodweiss. For similar reasons claims 14 and 24 are also allowable over Kodweiss.

Claim 34 is also allowable over Kodweiss. Claim 34 is directed to an intake module assembly that includes an air path extending from an inlet from an air filter to an outlet adapted

for communication with an engine cylinder head; a first shell; a second shell joined to the first shell to form the air path; a resonator integrally formed as part of the first and second shells; an intake manifold integrally formed as part of the first and second shells; and a throttle hose portion supported on at least one of the first and second shells forming a portion of the air path between the resonator and the intake manifold.

The examiner argues that Kodweiss discloses a first shell 20, 30; a second shell 22, a resonator 24, and a throttle hose portion, not shown, but connected to pipe 8. However, the examiner's throttle hose portion does not form a portion of the air path between the resonator and intake manifold as claimed. "The intake air flows through a resonance space 24 constructed in the resonance container 4, into the cylinder head (by way of the individual pipes 14, to 16), and thus into the combustion space of the individual cylinders." See col. 2, lines 30-34. Instead the throttle hose identified by the examiner is connected to pipe 8 as shown in Figure 1. Thus, Kodweiss does not disclose, suggest, or teach the features of claim 34.

Claim 35, which is dependent from claim 34 recites that the first and second shells are each comprised of a single piece component. For the reasons set forth above with regard to claim 1, claim 35 is also allowable over Kodweiss.

Claim 31 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kodweiss (US 6830024) in view of Ma (US 6085712). For the reasons set forth above, Kodweiss does not disclose, suggest, or teach the claimed invention. Ma does not make up for the deficiencies of Kodweiss.

Applicant believes that all claims are now in condition for allowance. An indication of such is requested. Applicant believes no additional fees are due, however, the Commissioner is

authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States patent and Trademark Office, fax number (571) 273-8300, on January 24 2007.

Laura Combs